

Remarks

The amendments and remarks presented herein are believed to be fully responsive to the Office Action dated August 6, 2004.

Claims 1-11 and 15-25 are pending in this application.

Amendment to claims

Claims 1, 2, 20, 23 and 24 are amended to further emphasize that the insertional mutagen is recessive. Claim 22 is canceled. Support is provided in the specification for the amendments to the claims. No new matter has been added.

Claim Rejections 35 U.S.C. § 103

The Examiner has maintained her rejection of Claims 1-11 and 15-25 under 35 U.S.C. § 103 as being unpatentable over Briggs et al. in view of Johnson et al. This rejection was traversed in the previous response to the Office Action. The Examiner considered the amendments and arguments presented by Applicants and has found them unconvincing. Accordingly, the claims have been amended above to further highlight distinguishing features Applicants believe distinguish the present invention over the cited references. The maintained rejection is traversed and reconsideration of the rejection in view of the above amendments and following remarks is respectfully requested.

Applicants' invention provides a means by which recessive mutations, which do not generally produce phenotypes in T1 transformants, can be generated and identified through analysis of related T2 plants. In contrast, Neff et al. was concerned with T1 progeny that exhibited a different hypocotyl phenotype from parent plants (see col. 38, lines 13-16). There is no evidence that Neff was interested in T1 transformants that did not exhibit phenotypes that differed from the parental line. There is no evidence that Neff et al. collected T2 seed from T1 transformants that did not exhibit any phenotypes of interest and analyzed for mutant traits "that were not present in its parent T1 plant" as recited in part (f) of claim 1. In the Advisory Action dated March 3, 2005, the Examiner also stated, "Neff et al. teaches an insertional mutagen capable of both gain- and loss-of-function mutations (col. 16, lines 2-28), where either mutation is dominant" [emphasis added]. Furthermore, in the Advisory Action of March 3, 2005, the Examiner stated, "Johnson teaches that his genetic marker is inherited in a dominant manner."

When combining references for an obviousness rejection the Examiner must provide the motivation to combine the references. Applicants have reviewed the cited references and is unable to located any teaching regarding a means by which recessive mutations, which do not generally produce phenotypes in T1 transformants, can be generated and identified through analysis of related T2 plants. Briggs does not make up for the missing teachings.

Because the Examiner has not provided reasoning as to how the prior art teaches or suggests these claimed features, *prima facie* obviousness has not been established, and the rejections under 35 U.S.C. §103 should be removed.

The Examiner made the following rejections against dependent claims: Claims 5-6 and 20-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al. and further in view of Tissier et al and Speulman et al.; Claims 2-3, 9, 22-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al., Tissier et al and Speulman et al. and further in view of Neff et al.; Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al., Tissier et al., Speulman et al., and Neff et al. and further in view of Dey et al. Claims 7, 11 and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al., Tissier et al., Speulman et al. and Neff et al. and further in view of Bhide et al.; Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al., Tissier et al., Speulman et al., Neff et al. and further in view of Williames; and Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. in view of Johnson et al., Tissier et al., Speulman et al., Neff et al. and Bhide et al., and further in view of Sandvik et al.

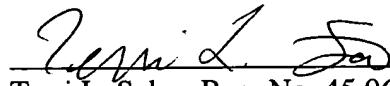
However, if an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, the rejections raised against the dependent claims are not addressed herein. Applicants make no admissions or concessions regarding the Examiner's assertions with respect to what the additional cited references disclose and their relevance to the claimed invention.

Closing remarks

It is believed that all of the rejections are overcome, and that the claims are in condition for allowance. The examiner is encouraged to telephone the undersigned to discuss any further issues that may need resolution prior to allowance.

Respectfully submitted,

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